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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/740,233 | 12/19/2000 | Kenneth F. Bugg | BELL-0063/00208 | 4489 |

7590 04/29/2003

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EXAMINER

FIGUEROA, FELIX O

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 04/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | | |
|-----------------|-------------------|--------------|------------------|
| Application No. | 09/740,233 | Applicant(s) | BUGG, KENNETH F. |
| Examiner | Felix O. Figueroa | Art Unit | 2833 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 February 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9, 11, 15 and 17-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9, 11, 15 and 17-19 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail (US 4,362,905) in view of Harrington et al. (US 4,738,635).

Ismail discloses an adapter comprising a housing (44) that defines an interior region and an exterior region, the housing having an entrance face (50); a plurality of electrical conductors (see fig.6) extending into the interior region of the adapter; a plug connector (46) coupled to a first subset of the electrical conductors; and a receptacle connector (56) coupled to a second subset of the electrical conductors. Ismail also discloses a data terminal (58) coupled to a third subset. Ismail also shows a plug face, a receptacle face and a terminal face.

Ismail discloses substantially the claimed invention except for the electrical conductors being coupled to a splitter. Harrington teaches the use of a splitter to provide connection to multiple lines. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to couple the conductors of Ismail to a splitter, as taught by Harrington, to provide connection to multiple lines.

Regarding claim 15, Ismail discloses (in Fig.6) substantially the claimed invention except for the data terminal comprising lugs. However, Ismail shows (in Figs.9&10) that

the use of lugs (94) is an equivalent structure known in the art for the structure of Fig.6. Therefore, because these two connecting elements were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious the use of lug as the connecting elements.

Regarding claim 17, it would have been within the skill of an ordinary worker in the art to provide a plug and a receptacle to be compatible with an in-line insertion of the interface adapter into a network.

Regarding claim 18, please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ismail and Harrington et al., in view Bell (US 5,930,340).

Ismail, as modified by Harrington, discloses substantially the claimed invention except for the splitter being an ADSL filter. Bell teaches the use of an ADSL filter (Fig.3) attached to a telephone network to isolate voice and data signals. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the splitter as an ADSL filter, as taught by Bell, to isolate voice and data signals.

Response to Arguments

Applicant's arguments filed 02/13/03 have been fully considered but they are not persuasive.

In response to applicant's arguments that Harrington "does not discloses a signal splitting", it is first noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). However, it is noted that the primary use of conductors of a telephone communication cable is to transfer electrical signal, thus Harrington discloses a signal splitter.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., splitting out high and low frequencies) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Harrington "does not discloses an interface adapter rot coupling to network conductors... ", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

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Art Unit: 2833

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Effective May 1, 2003, the United States Patent and Trademark Office has a new Commissioner for Patents address. Correspondence in patent related matters must now be addressed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

For additional information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

ffr
April 24, 2003



RENEE LUEBKE
PRIMARY EXAMINER